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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,762	07/26/2000	Hideto Horikoshi	JA919990082US1	8025

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EXAMINER

HARRY, ANDREW T

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,762

Applicant(s)

HORIKOSHI ET AL.

Examiner

Andrew T Harry

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-11,14-17 and 19 is/are rejected.
- 7) ☒ Claim(s) 7,8,12,13,18 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Drawings

The drawings are objected to because of the minor informalities indicated on the attached form PTO-948, Draftsperson's Drawing Review. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 3 – 6, 9 – 10, 14, 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by **Nelson et al. U.S. Patent 6,018,232** (Nelson).

As pertaining to **claim 1**, Nelson describes a method for receiving a wireless signal, in a computer adapted to operate in a power-saving mode (see Nelson, abstract), while the computer is in the power-saving mode (see Nelson col. 3 lines 18 - 21), comprising the steps of:

Art Unit: 2684

detecting within a computer a wireless signal representing a bit sequence, wherein said wireless signal is targeted for said computer (see Nelson col. 6 lines 25 – 31, Nelson describes that the device receives a paging message intended for the device, thus recognizing a bit sequence); and

exiting said power-saving mode automatically in response to said detection of said wireless signal (see Nelson col. 6 lines 39 - 47).

As pertaining to **claim 3**, Nelson describes a method for receiving a wireless signal, wherein the step of detecting a wireless signal targeted for said computer, includes the steps of:

detecting a particular identification tag embedded in said bit sequence (see Nelson col. 7 lines 7 – 24, Nelson describes that the paging message is scanned for information and therefore is scanning bit sequences looking for a specific bit stream or “tag”).

As pertaining to **claim 4**, Nelson describes a method for receiving a wireless signal, wherein wireless signal is transmitted through a radio frequency channel (see Nelson col. 4 lines 35 - 36).

As pertaining to **claim 5**, Nelson describes a method for receiving a wireless signal, wherein said bit sequence includes a request for said computer to exit said power-saving mode (see Nelson col. 7 lines 7 – 24).

As pertaining to **claim 6**, Nelson describes a method for receiving a wireless signal, wherein said bit sequence includes a request to continue execution of a program that is suspended while said computer is in said power-saving mode (see Nelson col. 7 lines 7 – 24).

As pertaining to **claim 9**, Nelson describes a method for receiving a wireless signal, further comprising the steps of:

Art Unit: 2684

processing information conveyed by said bit sequence (see Nelson col. 7 lines 33 – 38);
and

returning to said power-saving mode (see Nelson col. 7 lines 39 – 48).

As pertaining to **claim 10**, Nelson describes a computer for receiving a wireless signal while in a power savings mode, comprising:

a receiving means adapted to detect a wireless signal representing a sequence of bits, wherein said wireless signal is targeted for said computer (see Nelson col. 6 lines 25 – 36); and

a power saving mode control adapted to exit said power saving mode, when said wireless signal is detected while said computer is in a power-saving mode (see Nelson col. 7 lines 7 – 24).

As pertaining to **claim 14**, Nelson describes a computer wherein said receiving means is an optional attachment to said computer (see Nelson col. 5 lines 15 – 31, here Nelson describes that the modem interface is a PCMCIA slot, which is known to anyone of ordinary skill in the art that PCMCIA cards are changeable).

As pertaining to **claim 17**, Nelson describes a computer, comprising:

a receiving means within said computer, for receiving a signal representing a bit sequence (see Nelson col. 6 lines 24 – 31);

a power saving mode within said computer, for selectively entering and exiting a power-saving mode (see Nelson col. 5 lines 50 – 63); and

a detection means within said receiving means, for detecting a signal targeted for said computer while said computer is in a power-saving mode (see Nelson col. 7 lines 7 – 24); and

a control means within said power savings mode for exiting said power-saving mode in response to said detected signal (see Nelson col. 7 lines 7 – 24).

Art Unit: 2684

As pertaining to **claim 19**, Nelson describes a computer wherein said receiving means is an option card communicatively coupled to said computer through an option card bus slot See Nelson col. 5 lines 15 – 32).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 2, 11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nelson et al. U.S. Patent 6,018,232** (Nelson).

As pertaining to **claim 2**, Nelson's method also describes receiving a wireless signal, wherein said computer includes an wireless signal receiver device (see Nelson fig. 1 and col. 4 lines 33 – 41), and said computer includes one or more status signals indicating whether said wireless signal receiver device is installed and enabled (see Nelson col. 5 lines 15 – 31, Nelson describes the interface between the wireless modem and the processing unit of the device thus indicating to one of ordinary skill in the art that signals are passed indicating whether the device is, or is not present), wherein the step of exiting said power savings mode automatically in response to said detection of said wireless signal (see Nelson col. 6 lines 24 – 36), includes the steps of:

Art Unit: 2684

exiting said power-saving mode, only if said wireless signal receiver device is installed and enabled (see Nelson col. 6 lines 37 – 58, in order for Nelson's device to exit the suspended mode it must receive a wireless paging signal, thus indicating that the wireless device is installed and enabled).

Nelson does not explicitly state that his method includes determining whether said wireless signal receiver device is installed and enabled by reading said status signals. However it would have been obvious to one of ordinary skill in the art at the time of the invention that the interfaces that were described by Nelson (see Nelson col. 5 lines 15 – 31) between the computer and the wireless modem do, in fact exchange status signals. This exchange of status signals would have taken place in order for the two devices to be capable of communication with one another, and a processor automatically detecting a peripheral device is a practice that is well known in the art.

As pertaining to **claim 11**, Nelson's method also describes receiving a wireless signal, wherein said computer includes an wireless signal receiver device (see Nelson fig. 1 and col. 4 lines 33 – 41), and said computer includes one or more status signals indicating whether said wireless signal receiver device is installed and enabled (see Nelson col. 5 lines 15 – 31, Nelson describes the interface between the wireless modem and the processing unit of the device thus indicating to one of ordinary skill in the art that signals are passed indicating whether the device is, or is not present), wherein the step of exiting said power savings mode automatically in response to said detection of said wireless signal (see Nelson col. 6 lines 24 – 36), includes the steps of:

Art Unit: 2684

exiting said power-saving mode, only if said wireless signal receiver device is installed and enabled (see Nelson col. 6 lines 37 – 58, in order for Nelson's device to exit the suspended mode it must receive a wireless paging signal, thus indicating that the wireless device is installed and enabled).

Nelson does not explicitly state that his method includes determining whether said wireless signal receiver device is installed and enabled by reading said status signals. However it would have been obvious to one of ordinary skill in the art at the time of the invention that the interfaces that were described by Nelson (see Nelson col. 5 lines 15 – 31) between the computer and the wireless modem do, in fact exchange status signals. This exchange of status signals would have taken place in order for the two devices to be capable of communication with one another, and a processor automatically detecting a peripheral device is a practice that is well known in the art.

As pertaining to **claim 15 and 16**, Nelson does not describe in his disclosure that said receiving means is formed in a device bay cover and said device bay cover is an optional attachment to said computer. However it would have been obvious to one of ordinary skill in the art at the time of the disclosure to add a device bay cover option to the notebook device described by Nelson. This would have been an easy addition to Nelson's disclosure and would have added some aesthetic value to the device, also making it an optional attachment would have allowed the users of the device to individually select whether they would want the device bay cover.

Allowable Subject Matter

Claims 7, 8, 12, 13, 18, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As pertaining to **claims 7 and 12**, Applicant's claims 7 and 12 describes a computer that comprises a switch for maintaining power to said receiving means while s operating in power-saving mode, and further comprising the step of:

setting said switch to maintain power to said receiving means prior to entering said power-saving mode.

Nelson discloses that his device shuts down applications and processors in order to reduce power consumption. The idea of cutting the power to specific applications or processes in the device is not found in Nelson or in any other prior art made of record during the examination of this application.

As pertaining to **claims 8 and 13**, Applicants claims 8 and 13 describes a computer comprising a memory for storing bits;

wherein said receiving means is adapted to regenerates some or all of said bit sequence;
and

wherein said computer is adapted store said regenerated some or all of said bit sequence in said memory when said computer has exited said power-saving mode.

Nelson describes that his device receives a paging signal to alert his device to awake from a suspended mode. When Nelson's device receives this paging signal it processed the

Art Unit: 2684

signal, acts upon the processed information. Nowhere does Nelson mention that his device stores and attempts to reconstruct the signal. The idea of storing and reconstructing the signal that is received while the device is in power saving mode is not found in Nelson or any other prior art made of record during the examination of this application.

As pertaining to **claim 18**, Applicant's claim 18 states that in the computer at least one power source is disabled while said computer is in said power-saving mode;

wherein said receiving means asserts a wake up signal to said power-saving mode control means to indicate said wireless signal is received which is targeted for said computer; and

wherein said power management circuit in response to said asserted wake up signal enables said least one power source.

Nelson's device only contains one power source (battery pack) so there is no capability for his device to switch from one power source to another, as his device has no need for this capability. Additionally no other prior art made of record has the capability of cutting power from a power source and to re-enable to power source based on a wake up call. Therefore this subject matter is allowable over the prior art.

As pertaining to **claim 20**, the Applicant claims that the receiving means is a docking station. Nelson's disclosure says nothing about a docking station and explicitly states that his receiving means is via a pager or RF modem. Also no other prior art made of record during the examination of this application states that a docking station is used as the receiving means.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2684

B. Nelson et al. U.S. Patent 6,311,282 teaches a method and apparatus for a computing device with status display.

C. Russo U.S. Patent 6,167,078 teaches a method of power conservation in a serial modem.

D. Rotstein et al. U.S. Patent 6,289,228 teaches a method and apparatus for reducing power consumption of a communication device.

E. Scotton et al. U.S. Patent 5,524,021 teaches a method of modem power conservation.

F. Heiman et al. U.S. Patent 6,002,918 teaches a power-saving arrangement and method for mobile units in communications network.

G. Morelli U.S. Patent 5,838,720 teaches a transceiver control with sleep mode operation.

H. Morelli et al. U.S. Patent 6,236,674 teaches transceiver control with sleep mode operation.

I. Crump et al. U.S. Patent 5,530,879 teaches a computer system having power management processor for switching power supply from one state to another responsive to a closure of a switch, a detected ring or an expiration of a timer.

J. Enoki et al. U.S. Patent 5,471,624 teaches an apparatus and method for suspending and resuming software applications on a computer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Harry whose telephone number is 703-305-4749. The examiner can normally be reached on M-F 8:30 - 5:00.

Art Unit: 2684

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

ATH
June 20, 2002



DANIEL HUNTER
SUPERVISORY PATENT EXAMINER
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